

directed to more than one invention, and requires an election between:

- claims 1-27 drawn to a fluid meniscus process, classified in class 134, subclass 034 (identified by the Examiner as Group I);
- claims 28 and 29 drawn to a product, for example, an object containing an MEMS device, classified in class 428, subclass 1.1 (identified by the Examiner as Group II); and
- claim 30 drawn to an apparatus, classified in class 156, subclass 345.11 (identified by the Examiner as Group III).

In addition, the Office Action seems to maintain that the alternative language recited in claims 2, 3, 4, 10, 12, 20, 21, 22, 28 and 29 is directed to patentably distinct species of the invention, and requires an election of a single species within each of these claims.

Applicants provisionally elect with traverse the invention of Group I, i.e., claims 1 to 27. Examination of all three groups concurrently is requested, given the commonality of subject matter among the three groups.

The Manual of Patent Examining Procedure (M.P.E.P.) sets forth the requirements for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02). (M.P.E.P. § 803 (emphasis added)).

The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

Applicants respectfully maintain that the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time. Therefore, Applicants respectfully request that the Examiner examine all of the pending claims at the same time.

Applicant has also amended claims 2-4, 10, 12, and 20-22 to hereby elect, without traverse, one of the species of invention identified by the Examiner in each of claims 2-4, 10, 12, and 20-22. Applicants respectfully request that, upon the allowance of a generic claim, claims directed to other species including all the limitations of the generic claim be considered, in accordance with 37 C.F.R. § 1.141. Currently, at least claims 1, 5, 7-9, 11, 13-19 and 23-27 are generic to the elected species and one or more others of the identified species.

### CONCLUSION

Applicants respectfully request that the Restriction Requirement be withdrawn and all claims examined in this application. Applicants further note that to the extent the generic claims are allowable, all of the claims depending therefrom, including those claims that correspond to different species, must be allowed as well.

**FEES**

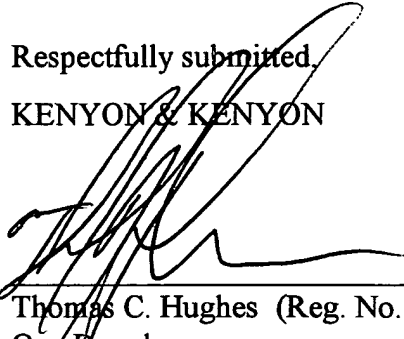
The Commissioner is authorized to charge any necessary fees or credit any overpayments under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Dated: April 30, 2003

By:

  
Thomas C. Hughes (Reg. No. 42,674)  
One Broadway  
New York, New York 10004  
(212) 425-7200

BEST AVAILABLE COPY

Marked-Up Version of Amended Claims Showing Changes Made

In the Claims:

Claims 2-4, 10, 12, and 20-22 have been amended without prejudice as follows:

2. (Amended) The fluid meniscus process of claim 1, wherein the object is a [selected from a group consisting of semiconductor wafer,] substrate [, metal and non-metal composites, metal and non-metallic material, silicon, indium phosphide, ceramic, glass, group IV element, group III-V compound, group II-VI compound, and binaries and ternaries thereof].

3. (Amended) The fluid meniscus process of claim 1, wherein the object is held to the holding fixture using [a method selected from a group consisting of mechanical means, vacuum means, electrostatic means,] fluidic means [, magnetic means and electromagnetic means].

4. (Amended) The fluid meniscus process of claim 1, wherein the fluid is [selected from a group consisting of] an etching fluid [, a plating fluid, a solvent, a photo resist, a developer and a stripper].

10. (Amended) The fluid meniscus process of claim 1, wherein the fluid etches at least a portion of the second surface of the object [, and wherein the object is selected from a group consisting of semiconductor wafer, substrate, metal and non-metal composites, metal and

non-metallic material, silicon, indium phosphide, ceramic, glass, group IV element, group III-V compound, group II-VI compound, and binaries and ternaries thereof].

12. (Amended) The fluid meniscus process of claim 1, wherein the fluid meniscus is used to perform [a function selected from a group consisting of] etching [, thinning, electroplating, micro-structure release, cleaning, electronic device fabrication, electrochemical processing, photochemical processing, photo-electro plating, optoelectronic processing, patterning, resist application, developing, plating, coating and stripping].

20. (Amended) The fluid meniscus process of claim 1, wherein the object is subjected to an electromagnetic energy source [selected from a group consisting of electromagnetic radiation, light, acoustical energy, mechanical energy, and thermal energy].

21. (Amended) The fluid meniscus process of claim 20 [1], wherein the [object is subjected to an energy source selected from a group consisting of electromagnetic radiation, light, acoustical energy, mechanical energy, and thermal energy, and wherein the] energy source is secured to the holding fixture.

22. (Amended) The fluid meniscus process of claim 20 [1], wherein the [object is subjected to an energy source selected from a group consisting of electromagnetic radiation, light, acoustical energy, mechanical energy, and thermal energy, and wherein the] energy source is secured to the holding tank.